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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
|--|-------------|----------------------|----------------------------|------------------------|
| 10/575,465   | 04/12/2006  | Reinhard Heine       | 016906-0495                | 3203                   |
| 22428  | 7590        | 12/13/2007           |                            |                        |
| FOLEY AND LARDNER LLP<br>SUITE 500<br>3000 K STREET NW<br>WASHINGTON, DC 20007 |             |                      | EXAMINER<br>LEO, LEONARD R |                        |
|  |             |                      | ART UNIT<br>3744           | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>12/13/2007    | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/575,465 | <b>Applicant(s)</b><br>HEINE, REINHARD |  |
|                              | <b>Examiner</b><br>Leonard R. Leo    | <b>Art Unit</b><br>3744                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/06</u> . | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

The preliminary amendment filed on April 12, 2006 has been entered. Claims 1-8 are pending.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "in particular for a motor vehicle" and "in particular oil cooler" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Villeval (FR 2 521 277) (Figure 3).

Claims 1-2, 4 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi et al (Figure 8).

Regarding claims 2 and 4, Figure 8 discloses the pipe connection of the coolant box 201 and connections of the oil cooler 202 are on the same wall of plane configuration.

Regarding claim 6, Figure 8 discloses a pipe connection centrally located between the oil cooler 202.

Regarding claim 7, Yamaguchi et al (column 4, lines 30-33) discloses the coolant box 211 is composed of resin.

Regarding claim 8, Figure 25 of Yamaguchi et al discloses plate-type oil coolers are well known.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al.

Yamaguchi et al discloses all the claimed limitations except a plastic coolant box.

Yamaguchi et al (column 4, lines 30-33) discloses the coolant box 211 is composed of resin.

It would have been obvious to one of ordinary skill in the art to employ a resin coolant box for the purpose of ease of manufacture and cost reduction. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 8, Figure 25 of Yamaguchi et al discloses plate-type oil coolers are well known. It would have been obvious to one of ordinary skill in the art to simply substitute one known element for another to obtain predictable results. *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395 (2007)

Claims 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al in view of Mansoux (FR 2 549 593).

The device of Yamaguchi et al lacks a larger gap between the connection wall of the coolant box and auxiliary heat exchanger than the opposite wall.

Mansoux discloses a radiator comprising a coolant box 1 containing an oil cooler 4 having a connection 19 on a wall thereof, and a larger gap between the connection wall of the coolant box and auxiliary heat exchanger than the opposite wall for the purpose of accommodating the bearing plate 11 with seals 17, 18.

Since Yamaguchi et al and Mansoux are both from the same field of endeavor and/or analogous art, the purpose disclosed by Mansoux would have been recognized in the pertinent art of Yamaguchi et al.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Yamaguchi et al a larger gap between the connection wall of the coolant box and auxiliary heat exchanger than the opposite wall for the purpose of accommodating the bearing plate with seals as recognized by Mansoux.

*Allowable Subject Matter*

Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard R. Leo whose telephone number is (571) 272-4916. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on (571) 272-4834. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/ LEONARD R. LEO /  
PRIMARY EXAMINER  
ART UNIT 3744

December 10, 2007